

## REMARKS

There are three independent method claims, 126, 128, and 129, and three corresponding independent system claims, 138, 142, and 145.

### **Claims 129 and 145**

Applicant addresses first claim 129 and its corresponding system form claim, 145. By the various exchanges, the issue for these claims has become focused on whether a method or system with the last element is obvious. The last element is:

“making the record available for look-up by anyone from any computer on the publicly accessible network.”

All web sites that are accessible on a network have some components that are accessible to more people and some components that are accessible to fewer people. There is no web site where all components have the same degree of availability to all. These differences are generally established by adjusting “security settings.” For example, for most web sites, only the site administrator or the host operator can delete files, and there are typically some files for the web site that even the site administrator can not delete and can not fully erase by writing over each spot on the hard disk where the data was stored, this function being limited to the host operator. As a more relevant example for the present issue, the site administrator usually has the power to revise any data that is presented on the site and others usually have very limited power or no power to revise data that is presented on the site. It is also common that a site will allow the world to view certain data collected at the site and allow only the site administrator to view other data collected at the site, such as number of site visits or IP addresses of visitors.

In the relevant prior art for claim 129, only the site administrator was allowed to view certain data, that is, records of who had obtained a license to use a work of authorship. This information was not made available to the general public. The question that the applicant and the Examiner are grappling with is whether making this information available to the general public is obvious. Although this change from the prior art can easily be made by a programmer, this does not answer the question of whether it was obvious to do so.

The body of the application articulates extensively that making this information available to the general public is non-obvious and is an important invention. I quote from the application with underlining added for emphasis:

### **BACKGROUND OF THE INVENTION**

This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use.

. . . .

The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work.

### **SUMMARY OF THE INVENTION**

Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license.

. . . .

In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted. . . . . The server of the licensing web page then automatically creates a license record associated with the

license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted.

....

When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser.

As described in the application above, the invented method is a solution to the problem of easy unauthorized copying of works of authorship that is completely different from the prior art solutions to this problem. There is nothing in the prior art which suggests this solution to the problem or motivates this solution to the problem. The prior art solutions of technical copy restriction and watermarking and the like all teach away from this solution. In contrast to the prior art technical solutions, the invention exploits the fact that humans are social animals and care what other people think of them when their actions are published for anyone to check on.

There is no teaching in Johnson that provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner. The examiner points out that "potential licensees" are allowed to access certain data in the system. However, they are not allowed to access "a record of the accepted license" as specified by element (f) of claim 129. The fact that they are members of the general public and are allowed access to some data does not make it obvious that they should be allowed access to other data to which only administrators are allowed access as taught by Johnson.

Thus, the examiner has not made a prima facie case of obviousness. Independent method claim 129 and the corresponding system claim 145 should be allowed at this time, along with the claims that depend from them.

If the Examiner is of the opinion that the argument above articulates a patentable invention but that the language of claim 129 is somehow too broad, the Applicant requests a telephone interview with the undersigned to discuss a satisfactory resolution.

### **Claims 126 and 138**

Applicant next addresses independent method claim 126 and its corresponding system form claim 138. They stand rejected under §103 as unpatentable over Johnson (US 5,991,876).

Applicant respectfully submits that the Examiner is still misreading Johnson. In particular, where the Examiner states on page 4: "See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60", none of these passages, when read carefully, supports the Examiner's view. Each of these passages refers to a "right" and not a copy of a work of authorship.

Johnson does not teach or suggest that a person could request or receive a "copy" of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are "rights". The "rights" that may be ordered in the system taught by Johnson are so intangible that they have no embodiments. Although each person in Johnson who orders a "right" relating to a work of authorship (in contrast to other kinds of property with which the system in Johnson is also designed to work) must have a copy of the work of authorship (or the original) to exercise that right, Johnson does not address how the person might get such a copy. Presumably, they already have a copy -- otherwise they would not know that they want a right to make copies or other copyright restricted uses of it. Element (e) of claim 126 specifies that a copy of the work of authorship is not provided across the network until after the user has accepted the terms of an offered license.

Even if one were to assume that a person who needs source materials to exercise the right they bought might, in some cases, be able download those materials from a site on the World Wide Web, Johnson does not suggest or imply that the materials might be delivered "as a consequence of" the person having indicated "acceptance of the offered terms and request for an electronic copy". The examiner acknowledges this limitation of Johnson on the lower half of page 6 of the office action. This is the crux of the matter.

The question then is whether it is obvious that the system of Johnson might be improved to add a feature that, once a customer buys a right to use materials by accessing a server across a network, the server will offer a chance to request that a copy be sent across the network and, if the customer requests such a copy, it is automatically sent to the customer across the network.

Under US patent law, some improvements are patentable and some improvements are obvious and therefore not patentable. The Applicant submits that, if it were obvious to make the claimed improvement to the system of Johnson, it would have been done between the date the Johnson application was filed in 1996 and the date the present application was filed three years later. This is a field in which there was intense inventive activity during those years.

The Johnson patent application discloses inventions made by the Copyright Clearance Center (CCC). In 1996, when the Johnson application was filed, the CCC did not maintain a computer system for providing copies of works of authorship across the Internet to general public licensees. The CCC provided (and still provides) a service to publishers to help them grant licenses to use their published works of authorship. The publishers published their works in various forms including electronic. Members of the public who saw or received a reference to one of those works could then go to the CCC to obtain a license to make a use of the work that was otherwise prohibited by copyright law. The licensees obtained their source materials directly or indirectly from the publishers, not from CCC. (The Applicant will provide a declaration on this point if desired.)

Thus, neither the system then publicly disclosed by CCC nor the system taught by Johnson is sufficient to implement the invention. A link is required to a database that contains copies of the works of authorship in question. Such a link is not suggested by Johnson. The Johnson system does not store the work itself or even have a link with access to the work. A prospective licensee has to access the Johnson system and enter the title of the work or the author's name in order to locate the licensing rules for the work. If the prospective licensee decides to license the content based on the stated rules, they pay the administrator of the Johnson system. There is no stated mechanism for how a copy of the licensed content might be delivered to the licensee. The assumption is that the user already has a copy of the work and is simply paying for rights to do

something with it other than merely read it. It was not obvious to Johnson or anyone else to provide these functions because the repository only stores rights info about the work, it does not store the work itself.

To make a prima facie case that an improvement is obvious, the Examiner must point to a teaching, suggestion, or motivation in the reference itself or in the knowledge generally available to one of ordinary skill in the art that the improvement should be made to the prior art system.

In support of her conclusion of obviousness, the Examiner states "it is well-known to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use." This may be well-known now, but it was not well known when the present patent application was filed in 1999, particularly for a system "usable by a plurality of publishers" as specified by element (a) of claim 126. Applicant submits that the present inventor was the first to invent the claimed method of doing so upon request as part of a transaction to secure the rights and that this is a significant invention.

As another part of her analysis on this point, the Examiner states, at the bottom of page 6: "Johnson et al. discloses that once the third computer (the client) accepts the terms and the acceptance is acknowledged, the third computer/client is allowed to access and use an electronic copy of the work via the network." The underlined portion of this sentence is wrong. To show that it is wrong, the Applicant analyzes below each relevant passage of Johnson.

Figure 7 does not teach that the system may offer, or a user may receive "a copy of the work of authorship". Figure 7 teaches that, when a prospective licensee requests a license, the licensee may be required to specify whether the type of use will be on paper or electronic and the number of copies that the licensee wishes to make. The fact that a user is requested to state what kind of use the user will make of the rights obtained does not imply that the server can send a copy of a work of authorship. Figure 7 does not teach that a user of the server system may place an order for a copy to be delivered, in any form, or that the server system is capable of delivering a copy in any form.

In column 7 at lines 1 - 10 Johnson states that the types of works for which copyrights might be licensed and managed by the system include works that may be

embodied in electronic copies. However, Johnson says nothing about delivering electronic copies of those works to licensees.

In column 7 at lines 40 - 55, Johnson explains that the type of use for which a prospective licensee may seek permission may be specified, such as: educational, not for profit, commercial, on paper, in an optical memory, in a computer memory serving an intranet, or in a computer memory serving the internet. This paragraph in Johnson does not teach either that a prospective licensee can place an order for a copy of a work of authorship or that the system could be made capable of delivering a copy of a work of authorship.

In column 9 at lines 35 - 55, Johnson states that the right ordered might be the right to make electronic copies of the work. However, Johnson says nothing about allowing the licensee access to an electronic copy of the work to make these copies. This paragraph of Johnson merely teaches that "rights" can be ordered, not that copies can be ordered or that the system has the ability to deliver the work upon acceptance of the license.

In column 10 at lines 40 - 60, Johnson discusses the user interface through which a prospective licensee will place an order for rights. When the prospective licensee places the order, the licensee may be required to specify whether the use will be made on paper or electronically and the number of copies that the user will make. This paragraph of Johnson does not teach either that the prospective licensee may place an order for copies or that the server system can deliver copies.

Claims 126 and 138 are therefore allowable. Claims 134 and 135, which depend from claim 126, are independently allowable for additional reasons. Claim 134 specifies that the delivered electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship. This is not taught by Johnson. Claim 135 specifies that the electronic copy of the document includes a hot spot which takes a person to the web page described in claim 134. Neither Johnson nor any other cited art teaches any such hot spot.

#### **Claims 128 and 142**

Claims 128 and 142 stand rejected under §103 as unpatentable over Johnson (US 5,991,876) in view of a reference (Elsevier) showing that a service of providing paper reprints of works of authorship was in the prior art. There are many such references that could be cited for this proposition.

The essential question is whether it was obvious to combine such a service with a server for granting reprint licenses such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then be sent by the server system to a printer for printing on paper and delivery.

To address this question, Applicant begins by noting, as did the Examiner, that a combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance. Thus, the question is whether it is obvious to add this improvement to the system of Johnson.

In 1996 when the Johnson application was filed, the CCC did not maintain a computer system that was capable of sending copies of works of authorship to a printer for printing reprints. (The Applicant will provide a declaration on this point if desired.) Thus, neither the system then used by CCC nor the system taught by Johnson is sufficient to implement the invention. In addition, a link is required to a database that contains printable copies of the works of authorship in question. Such a link is not suggested by Johnson or Elsevier.

Claims 128 and 142 are allowable and should be allowed at this time, along with the claims that depend from them.

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